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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91174575
Party	Defendant Cohen, Douglas A. Cohen, Douglas A. 500 N. State College Blvd, Suite 550 Orange, CA 92868
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Submission	Answer
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Date	01/24/2007
Attachments	COHENAnswer&AffirmativeDefs.pdf ( 7 pages )(328730 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/754,127, E ENSURANCE.COM  
Published in the *Official Gazette* on October 17, 2006

ESURANCE, INC.

Opposer

v.

DOUGLAS A. COHEN,

Applicant.

Opposition No. 91174575

**ANSWER AND AFFIRMATIVE DEFENSES  
TO NOTICE OF OPPOSITION**

Applicant, Douglas A. Cohen (hereinafter "Applicant"), answers the Notice of Opposition filed by Opposer, Esurance, Inc. (hereinafter "Opposer"), as follows, the paragraphs hereof being numbered to correspond with the like-numbered paragraphs of the Notice of Opposition (hereinafter "Notice"):

Applicant denies the introductory claim, preceding paragraph 1 of the Notice, that Opposer would be damaged by registration of Applicant's mark E ENSURANCE.COM and Design. Applicant admits only that it filed U.S. Application Serial No. 78/754,127 for E ENSURANCE.COM and Design for "quoting, underwriting, and writing of insurance, namely property and casualty, life, health, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker's compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning" in International Class 36, and is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set for this paragraph and, therefore, denies same.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 1 of the Notice and therefore, denies same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 2 of the Notice and therefore, denies same.

3. Applicant admits only that an uncertified copy of Certificate of Registration No. 2,708,357 is attached to the Notice. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set forth in paragraph 3 of the Notice and therefore, denies same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 4 of the Notice and therefore, denies same.

5. [There is no paragraph number "5" in the Notice to which a response is required.]

6. Applicant admits only that on November 15, 2005, it filed U.S. Application Serial No. 78/754,127 for E ENSURANCE.COM and Design for "quoting, underwriting, and writing of insurance, namely property and casualty, life, health, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker's compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning" in International Class 36, based on use of that mark since at least as early as October 1998, and is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set for in paragraph 6 and therefore, denies same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 7 of the Notice and therefore, denies same.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 8 of the Notice and therefore, denies same.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 9 of the Notice and therefore, denies same.

10. Applicant denies the allegations set forth in paragraph 10 of the Notice.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 11 of the Notice and therefore, denies same.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 11 of the Notice and therefore, denies same.

13. Applicant denies the allegations set forth in paragraph 13 of the Notice.

14. Applicant denies the allegations set forth in paragraph 14 of the Notice.

15. Applicant denies the allegations set forth in paragraph 15 of the Notice.

16. Applicant denies the allegations set forth in paragraph 16 of the Notice..

In response to Opposer's prayer for relief, Applicant denies that Opposer will be damaged by registration of Applicant's mark, which is the subject of Application Serial No. 78/754,127 and submits that the opposition should be dismissed in its entirety.

#### **AFFIRMATIVE DEFENSES**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.

2. Applicant's mark E ENSURANCE.COM and Design, which is the subject of U.S. Application Serial No. 78/754,127, is not likely to cause confusion, mistake, or deception or otherwise damage Opposer, or Opposer's alleged names or marks.

3. Applicant's mark, which is the subject of U.S. Application Serial No. 78/754,127, is visually, aurally and semantically distinct from Opposer's alleged ESURANCE mark.

4. On information and belief, the respective relevant consumers and customers of the parties' services are likely to be sufficiently sophisticated and/or discriminating in their purchase of financial and insurance services as to avoid any likelihood of confusion.

5. On information and belief, Applicant's use and registration of the mark E ENSURANCE.COM and Design, which is the subject of U.S. Application Serial No. 78/754,127, in connection with its services in Class 36 is not likely to cause consumers to believe that Applicant or its services are in some way associated, sponsored or approved by Opposer, because the marks are different and/or distinguishable in overall appearance, pronunciation and commercial impression.

6. On information and belief, the parties have coexisted in the marketplace and currently used their respective marks, ESURANCE and E ENSURANCE.COM and Design, in connection with their services for over 8 years without any instances of actual confusion among customers or consumers. As such, there is no likelihood of confusion in the future.

7. On information and belief, Petitioner has no interest or rights in or to the term "ESURANCE" *per se*, the term "ENSURANCE" in combination with another

term, symbol or device, or E ENSURANCE.COM and Design, which is the subject of U.S. Application Serial No. 78/754,127, in connection with financial, insurance and related services, prior to Applicant.

8. On information and belief, Opposer does not own prior to Applicant's first use of E ENSURANCE.COM and Design, nationwide trademark rights in the term ESURANCE or variants thereof.

9. Applicant has marketed, advertised, promoted, offered for sale and sold financial, insurance and related services in interstate commerce in connection with its mark E ENSURANCE.COM and Design, which is the subject of U.S. Application Serial No. 78/754,127, since at least as early as October 1998. Applicant thereby has established and acquired valuable goodwill in the mark E ENSURANCE.COM and Design in connection with its services, developing an asset of considerable value to Applicant. Opposer did not object to Applicant's application for or use E ENSURANCE.COM and Design until it filed its Notice of Opposition on December 15, 2006. Indeed, Applicant has for many years marketed and promoted Opposer's services on its web site at [www.ensurance.com](http://www.ensurance.com) and referred customers to Opposer, without any actual confusion or objection from Opposer. Opposer knew or should have known of Applicant's application, use and registration long before the filing date of its Notice of Opposition. As a result, Applicant detrimentally relied on Opposer's delay and inaction and will be damaged if the Notice of Opposition is sustained because it will be denied the benefits associated with a Federal Trademark Registration. Accordingly, Opposer's claims in the Notice of Opposition are barred under the doctrines of estoppel by laches, estoppel by acquiescence and/or equitable estoppel.

10. On information and belief, Opposer has not and is not likely to suffer any injury or damage as a result of Applicant's use and registration of the mark E ENSURANCE.COM and Design which is the subject of U.S. Application Serial No. 78/754,127.

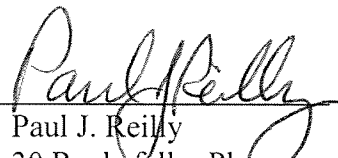
WHEREFORE, Applicant requests that Opposition No. 91174575 be dismissed in its entirety and that registration be granted on its Application Serial No. 78/754,127 for E ENSURANCE.COM and Design.

Respectfully submitted,

BAKER BOTTS, L.L.P.

Dated: January 24, 2007

By:

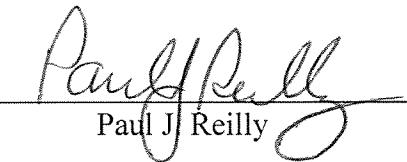
  
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New York, N.Y. 10112  
212.408.2500  
Attorneys for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing, **ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION**, was served on the attorneys for Applicant via Federal Express Courier, in an envelope with sufficient postage addressed to:

Mary R. True, Esq.  
Frost Brown Todd LLC  
2200 PNC Center, 201 East Fifth Street  
Cincinnati, OH 45202

on January 24, 2007

By:   
Paul J. Reilly